

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS

In re Application of: Roy McGee

Date: August 19, 2002

Serial No.: 09/934,349

Group Art Unit: 3742

Filed: 08/21/2001

Examiner: Joseph Moore Pelham

Title: 12-Volt Heated Coffee Mug

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Terry Lakos
Name:

9/9/02
Date

TERRY LAKOS

BRIEF ON APPEAL UNDER 37 C.F.R. 1.192

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is an appeal from the Final Rejection, dated May 09, 2002 for the above identified application.

REAL PARTY IN INTEREST

The party(ies) named in the caption of this brief are the real parties of interest in this appeal.

RELATED APPEALS AND INTERFERENCES

RECEIVED

SEP 25 2002

TECHNOLOGY CENTER R3700

There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-6 remain pending and appealed in the present applications.

STATUS OF AMENDMENTS

There have been no supplemental amendments filed after final rejection.

SUMMARY OF INVENTION

Referring to the specification, page 5 line 10 through page 7, line 8 and FIG. 1-2, a heated coffee mug apparatus 5, according to the preferred embodiment of the present invention, provides generally a standard drinking vessel 10, surrounded by and in firm mechanical communication with a coffee mug holder 15. The mug holder 15, which will be described in greater detail below, comprises a radially elongated base 17, wrapped around the lower circumference of the drinking vessel 10. The base 17 has a flat lower surface for resting upon a horizontal surface, but also can be held in place via a first hook fastening means 20 and a loop fastening means 22. The first hook fastening means 20 is secured to the base 17, via adhesive or similar material. The loop fastening means 22 is secured to a flexible fabric strap 27. The flexible fabric strap 27 is secured to the horizontal surface by tape or other similar adhesive.

Electrical power is supplied to the base 17 via a power cord 30. The power cord 30 is electrically coupled with a power plug 32. The power plug 32 is capable of connecting directly to a motor vehicle's power system. The power plug 32 is also capable of connecting to a power receptacle. The power receptacle 35 is electrically coupled to a heating element 28 , via a power cord 39 as described below.

The heating element comprises a flexible resistive type heat element 50 located on the is on the interior side of the coffee mug holder15, to provide heat via direct mechanical communication to the standard containerized food vessel 10 (shown in FIG. 1). Located directly above, but not in direct mechanical communication with the flexible resistive type heat element 50, is a controlling thermostat 54. The controlling thermostat 54 is provided with a pair of fixed set points of 130 degrees Fahrenheit for high and 110 degrees Fahrenheit for low. Occupying the remainder of the space within the coffee mug holder 15 is an insulating media (not shown), which is used to direct the heat from flexible resistive type heat element 50 into the standard drinking vessel 10, and protect the user from direct contact with high temperatures.

Referring now to FIG. 2, an electrical schematic diagram illustrating the electrical components is shown. The flexible resistive type heat element 50 is connected in a series arrangement with the controlling thermostat 54, the power cord 30, and the power plug 32. As can be visualized via this arrangement, the controlling thermostat 54, will provide the regulation required for safe operating conditions. Additionally, FIG. 2 depicts the power receptacle 35, the power cord 39, and the power pack 37. The power pack 37, consists of a step-down transformer 60, and an electrical connector 62,

to allow for connection to standard alternating current electrical power systems as found in residences and businesses.

ISSUES

In the final office action dated May 09, 2002, the Examiner rejected Claims 1-4 under 35 U.S.C. 102(b) as being anticipated by Vaneslow and claims 5-6 under 35 U.S.C. 103 under the same reference. Therefore, the issues on appeal are:

1. Does Vaneslow identically claim and disclose claims 1-4 of the present invention? And
2. Are claims 5-6 of the present invention anticipated as being obvious by Vaneslow?

GROUPING OF CLAIMS

Claims 1-4 form a first group of claims, and claims 5-6 form a second group of claims that each stand or fall independently of the other group of claims.

ARGUMENT

1. Rejections under 35 U.S.C. 102

The present invention includes a number of features that are unanticipated in the above mentioned references. Claims 1-4 were rejected under 35 U.S.C. 102(b) as being anticipated by Vaneslow.

In undertaking to determine whether one reference anticipates another under 35

U.S.C. 102(b), a primary tenet is that only the CLAIMED designs are to be compared. Many differences exist between the design claimed in Vaneslow, and the currently claimed design. To briefly summarize the distinguishing features and characteristics of each, Vaneslow, discloses and claims a cup warming device having a receiving member with an extended cylindrical cavity.

The present invention includes a number of features that are unanticipated in the above mentioned references. For example, the present invention includes:

- a lid;
- a heating elements retained within a base AND powered by 12 volts DC ;
- The ability to use the base with a standard drinking mug;
- a power plug is capable of connecting directly to a motor vehicle's power system;
- a flexible resistive type heat element located on the interior side of the coffee mug holder, to provide heat via direct mechanical communication to the standard containerized food vessel.

Accordingly, the rejection by the examiner under 35 U.S.C. 102(b) is inappropriate. Therefore, rejection under 35 U.S.C. 102(b) is inappropriate.

2. Rejections under 35 U.S.C. 103

The examiner respectfully rejected Claim 5-6 under 35 U.S.C. 103(a) as being unpatentable over the same single reference. Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument application wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention

based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of making heating element powered by a vehicle's electrical system for heating a conventional drinking mug in a manner that flexibly retains the mug in firm mechanical contact. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However,

there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Further, in rejecting claims under 35 U.S.C. 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. 1993) A prima facie case of obviousness is established by presenting **evidence** that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Although many sources of suggestion are allowed, this requirement for actual evidence must be met with a clear and particular showing. See, e.g. C.R. Bard Inc. v. M3 Sys., Inc. 1527 F.3d 1340, 1352, 48 USPQ2d 1255, 1232 (Fed. Circ. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re

Dembiczak, 175 F.3d 994, 999, 50 USPQ 1614, 1617 (Fed. Cir. 1999).

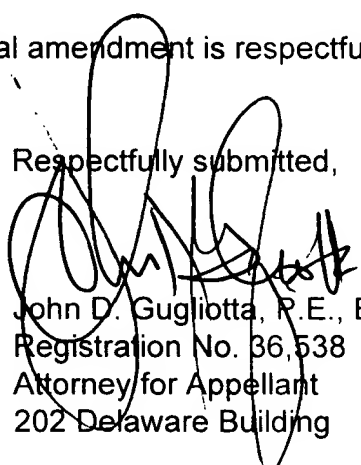
To summarize, it appears that the examiner is holding us to a much different standard of obviousness than any of the other patent applications that have been cited as the relevant art. only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, the examiner's rejection of claims 2-3 under 35 U.S.C. 103(a) on obviousness grounds was improper. Most importantly there is no suggestion in any of the references for the combination proposed. If a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination.

Orthopedic Equipment, supra.

The claims as amended should therefore be allowable and the application be put in a condition for allowance. Accordingly, the reversal of the Examiner by the honorable Board of Appeals and entry of the supplemental amendment is respectfully solicited.

Respectfully submitted,



John D. Gugliotta, P.E., Esq.
Registration No. 36,538
Attorney for Appellant
202 Delaware Building

-9-

137 South Main Street
Akron, OH 44308
(330) 253-5678
Facsimile (330) 253-6658

THE CLAIMS ON APPEAL

The claims on appeal are as follows:

1. A heated coffee mug comprising:
 - a cup with a handle and forming an upper opening orifice;
 - a lid for affixing to said cup to enclose said upper opening orifice;
 - a base for receiving said cup and provide stability on a horizontal surface; and
 - heating elements retained within said base, said heating elements powered by 12 volts DC as provided by a motor vehicle to maintain the hot temperature of the contents of said cup.

2. (Once Amended) A heated coffee mug apparatus comprising:
 - a generally standard drinking vessel;
 - a mug holder for surrounding and providing firm mechanical communication with said drinking vessel, said mug holder having a base having a flat lower surface for resting upon a horizontal surface;
 - a heating element located within said mug holder; and
 - a power cord electrically coupled with a power plug and in electrical communication with said heating element.

3. The heated coffee mug apparatus of Claim 2, wherein said power plug is capable

of connecting directly to a motor vehicle's power system.

4. The heated coffee mug apparatus of Claim 3, wherein said power plug is also capable of connecting to a power receptacle.

5. The heated coffee mug apparatus of Claim 2, wherein said heating element comprises a flexible resistive type heat element located on the interior side of the coffee mug holder, to provide heat via direct mechanical communication to the standard containerized food vessel

6. The heated coffee mug apparatus of Claim 2, wherein said heating element further comprises a controlling thermostat provided with a pair of fixed set points.